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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,011	12/21/2001	Steven K. Lee	2432	2625

7590 11/09/2004

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EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,011

Applicant(s)

LEE, STEVEN K.

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Owensby(6647257) in view of Greenberg(5379345).

Regarding claim 1, Owensby (See abstract, Figs. 1-3, Col. 10, lines 30-50 claims 1, 21, and 33) disclose method for subsidizing the cost of a wireless network by inserting a commercial advertisement in the data stream substantially as claimed. The differences between the above and the claimed invention is the use of a buried message. It is noted that it is believed that the advertisements included in the wireless transmission are functionally equivalent to the buried message. Greenberg (See Fig. 1, Col. 4, lines 35-50) show a wireless message with a key controlled buried digital message. It would

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have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Owensby because the inserted messages are conventional functional equivalents with respect to the claim limitations and Owensby contemplates a degree of user response(See bridging paragraph of cols. 20 an 21). Regarding claim 2, Owensby (See abstract, Figs. 1-3, Col. 10, lines 30-50 claims 1, 21, and 33) disclose means for subsidizing the cost of a wireless network by inserting a commercial advertisement in the data stream substantially as claimed. The differences between the above and the claimed invention is the use of a buried message. It is noted that it is believed that the advertisements included in the wireless transmission are functionally equivalent to the buried message. Greenberg (See Fig. 1, Col. 4, lines 35-50) show a wireless message with a key controlled buried digital message.

It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Owensby because the inserted messages are conventional functional equivalents with respect to the claim limitations and Owensby contemplates a degree of user response(See bridging paragraph of cols. 20 and 21). Regarding the interface limitations of claim 3, Owensby contemplates a degree of user response(See bridging paragraph of cols. 20 an 21 and Fig. 2) which is a functional equivalent of the claim limitations. Regarding the address limitations of claim 4, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of

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the claim limitations. Regarding the unique address limitations of claim 5, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding claim 6, Owensby (See abstract, Figs. 1-3, Col. 10, lines 30-50 claims 1, 21, and 33) disclose means for subsidizing the cost of a wireless network by inserting a commercial advertisement in the data stream substantially as claimed. The differences between the above and the claimed invention is the use of a buried message. It is noted that it is believed that the advertisements included in the wireless transmission are functionally equivalent to the buried message. Greenberg (See Fig. 1, Col. 4, lines 35-50) show a wireless message with a key controlled buried digital message. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Owensby because the inserted messages are conventional functional equivalents with respect to the claim limitations and Owensby contemplates a degree of user response (See bridging paragraph of cols. 20 and 21). Regarding the control limitations of claim 7, Owensby (see Fig. 4, Col. 1, lines 60-65) show a signal identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding the unique address limitations of claim 8, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding the key limitations of claim 9, Greenberg (See Fig. 1, Col. 4, lines 35-

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50) show a wireless message with a key controlled buried digital message which is a functional equivalent of the claim limitations. Regarding the key limitations of claim 10, Greenberg (See Fig. 1, Col. 4, lines 35-50) show a wireless message with a key controlled buried digital message which is a functional equivalent of the claim limitations. Regarding the pay option limitations of claim 11, Owensby (see Fig. 4, Col. 21, lines 20-30) show a signal identifier for a mobile unit with no subsidy which is a functional equivalent of the claim limitations. Regarding the content limitations of claims 12-14, Owensby (see Fig. 3, Col. 6, lines 50-65) show a variable content for a mobile unit which is a functional equivalent of the claim limitations. Regarding the status limitations of claim 15, Owensby (see Fig. 4, Col. 21, lines 20-30) show a status identifiers for a mobile unit which is a functional equivalent of the claim limitations. Regarding the unique address limitations of claim 16, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding the access limitations of claim 17, Owensby (see Fig. 4, Col. 1, lines 60-65) show a signal identifier for a mobile unit from a gateway which is a functional equivalent of the claim limitations. Regarding the pay option limitations of claim 18, Owensby (see Fig. 4, Col. 21, lines 20-30) show a signal identifier for a mobile unit with no subsidy which is a functional equivalent of the claim limitations.

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Regarding claim 19, Owensby (See abstract, Figs. 1-3, Col. 10, lines 30-50 claims 1, 21, and 33) disclose method for subsidizing the cost of a wireless network by inserting a commercial advertisement in the data stream substantially as claimed. The differences between the above and the claimed invention is the use of a buried message. It is noted that it is believed that the advertisements included in the wireless transmission are functionally equivalent to the buried message. Greenberg (See Fig. 1, Col. 4, lines 35-50) show a wireless message with a key controlled buried digital message. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Owensby because the inserted messages are conventional functional equivalents with respect to the claim limitations and Owensby contemplates a degree of user response (See bridging paragraph of cols. 20 and 21).

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims contain the terms "can " or "capable" which is not a positive limitation. (See In re Collier, 158 USPQ 266) It is not clear what is being claimed. For example, anything can be used to perform or is capable of a specific function given

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sufficient time and resources.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number (703) 305-1837. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington, D.C. 20231

or faxed to (703)872-9306

Hand delivered responses should be brought to Crystal Park V, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor(Receptionist).


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is (703) **308-4177**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222